

REMARKS

Please note the fact that May 10, 2008, fell on a Saturday ensures that this paper is timely filed as of today, Monday, May 12, 2008 (the next succeeding day which is not a Saturday or Sunday).

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 1, 3-6, 8, 10-14, 16, 20, and 23 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1 and 12 are independent; the remaining claims are dependent claims. Claims 1, 3-6, 8, 10-14, 16, 20, and 23 stand rejected under 35 U.S.C. § 103. Applicants respectfully request reconsideration and withdrawal of these rejections.

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. On April 10, 2008, Applicants' representative and the Examiner conducted a telephone interview in which the Section 103 rejections were discussed. No agreement was reached with respect to the claims. It was agreed, however, that Applicants would submit an amendment and if the claim amendments made therein did not overcome the Section 103 rejection the Examiner would call Applicants' representative before issuing a further Office Action.

Applicants are not conceding in this application the claims amended herein are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants specifically state no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Rejections under 35 U.S.C. 103(a)

Claims 1, 3-6, 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz (US 6,029,150) (hereinafter "Kravitz") in view of Martino (US 6,574,314) (hereinafter "Martino") in view of Vatanen (US 6,169,890) (hereinafter "Vatanen") in view of Morrill, Jr. (US 5,991,749) (hereinafter "Morrill") in view of Herlin (US 6,023,689) (hereinafter "Herlin") and further in view of Herbert (US 6,023,509) (hereinafter "Herbert"). Claims 14, 20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz in view of Martino, in view of Vatanen in view of Morrill, in view of Herlin, in view of Herbert, and further in view of Kikinis (US 6,055,566) (hereinafter "Kikinis"). Applicants respectfully request reconsideration and withdrawal of these rejections.

Applicants respectfully disagree with the rejection of the claims under Section 103, but have amended the independent claims to further emphasize they are directed to allowable subject matter. Independent claims 1 and 10 have been amended to recite, *inter alia*, the following limitations: "subsequent to authentication, placing a purchase

order utilizing said voice channel connection of said communication device” (Claims 1 and 10); “wherein said steps between the telecommunications provider and the payment provider are employed utilizing fully automated equipment” (Claims 1 and 10); and “wherein said steps of receiving the electronic bill, acknowledgement of said electronic bill by a user, creation of the money transfer order and transmission of said money transfer order to the payment provider, and receiving the receipt of payment from said payment provider and forwarding said receipt of payment to said provider of goods and services, are performed by executing a computer program product embodied on the subscriber identification module (SIM) of said electronic communication device” (Claims 1 and 10). Support for the first limitation is present in the Specification in the discussion of the steps for the method of payment. (Specification, Page 3, Paragraph 1). Support for the second limitation is found in the language “objects of the present invention are accomplished by a computer program product (software) which is preferably embodied on a cellular phone chip, e.g. on the SIM card, which computer program product comprises computer program code means adapted to perform the following steps when run on an electronic communication device...” (Specification, Page 4, Paragraph 1). This limitation of storing the computer program product directly onto the SIM card is not found in the prior art cited by the Examiner. Further, the steps in Claims 1 and 10 were rewritten to include the term “subsequent” to highlight the logical order of the steps as presented in the specification. (Specification, Page 3, Paragraph 1). Support for the remaining amendments appears throughout the specification. At the very least these new limitations added to the claims are not found in any of the art cited by the Examiner, and it is Applicants’ position that the independent claims as amended are thus clearly directed to

allowable subject matter. It is therefore respectfully requested that the Section 103 rejections be withdrawn.

To the degree that Applicants have previously addressed the above-mentioned rejections in their responses, those comments are fully incorporated by reference as if set forth herein.

As the Examiner is no doubt aware, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to modify a reference or combine references; a reasonable expectation of success in making the modification or combination; and the prior art must teach or suggest all the claim limitations. *See, e.g. In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As an initial matter, Applicants respectfully direct the Examiner's attention to the instant Specification wherein it states: "objects of the present invention are accomplished by [a particular method] based on existing sophisticated security mechanisms as provided by SIM cards and the existing billing system of the telecommunication companies." (Specification, Page 2). Thus, it is unremarkable that the Examiner is able to find some of the elements of the instantly claimed invention in a number of prior art references, as the instantly claimed invention, in certain aspects, makes use of various components and techniques that already exist. Applicants respectfully submit, however, that the instantly claimed invention makes a novel and nonobvious combination of existing elements, along with novel and nonobvious method steps, to produce the instantly claimed invention.

Applicants respectfully submit that merely listing the elements of the invention, to the extent the Examiner is able to do so, in a piecemeal fashion from various references to support a case of obviousness without providing sufficient suggestion or motivation for doing so, and without taking into account the overall teachings of the references in the process, is improper. MPEP § 2142. Applicants respectfully submit that the Examiner has not pointed to prior art references that teach, either alone or in combination, all the limitations of the instantly claimed invention; furthermore, the Examiner has not provided evidence of obviousness based on a suggestion or motivation to combine the references by taking into account the teachings of the entire reference.

As best understood, Morrill does not teach that the “telecommunication provider authenticates that the customer is authorized to give money transfer order using ID (*SIM*) of the sending telephone” at Col. 4, lines 1-64, as the Examiner contends. *Office Action*, pp. 4. Rather, Morrill teaches that the telecommunication provider identifies the customer by ID number, *but utilizes other information in order to determine that the customer is authorized to give a money transfer order*. Morrill, Col. 5, lines 14-19. Indeed, Morrill explicitly states that a “PIN might not be required for a pre-paid (stored value) account with the mobile phone service provider up to a certain amount such as \$20 or \$50. But in this case, [in the example case a customer is buying food for \$4.50 from a food vendor utilizing a checking account] *security requires a PIN*. Therefore, Morrill is clearly distinguishable from the instantly claimed invention “wherein *the telecommunication provider authenticates that the customer is authorized to give a money transfer order using the subscriber identification module (SIM) of said electronic communication device*”. Claim 1 (emphasis added). This language clearly indicates that

in the instantly claimed invention, no “PIN” is required in addition to the SIM identification in order to authenticate that the customer is authorized to give any kind of a money transfer order; instead the “very sophisticated billing system established by the telecommunication providers to charge purchase payment costs with the monthly telecommunication bill” are utilized, thus facilitating increased purchasing power of individuals. (Specification, Page 5).

Thus, although the Examiner continues to assert that “these concepts are old and well known”, *Office Action*, pp. 5, Applicants respectfully submit that the Examiner is citing prior art against elements of the invention that are listed in the specification itself as prior art, and that the Examiner has not found a reference (or combination of references) that renders the instantly claimed invention obvious within the meaning of 35 USC 103(a). Applicants respectfully request that the rejections of the claims founded upon some combination with Morrill (i.e. all of the section 103(a) rejections) be withdrawn, as the prior art must teach or suggest all the claim limitations. *See, e.g. In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner asserts that Herlin teaches “the use of a SIM for authentication at Col. 2, lines 10-20.” *Office Action*, pp. 4, apparently in an attempt to suggest that Herlin and Morrill render obvious the limitation that the customer is authorized to purchase using other accounts based on SIM, rather than, e.g., submission of a PIN or a credit card number. As has been explained, however, that SIM is routinely used for authentication in a communications setting is disclosed in the original Specification itself on page 1 and repeated throughout the specification. The instantly claimed invention relies on this fact

to make *purchasing* easier while maintaining and in fact increasing security, as it is put in the specification: “[t]he authorization of the customer is achieved by the identification and call metering mechanisms of the cellular standard networks, e.g. the use of the SIM and existing service channels. This results in a very fast execution of the payment method according to the present invention.” (Specification, Page 3). Thus, the invention is accessible to “[m]illions of users [that] are in possession of GSM chip card[s] (SIM) in their mobile phone and each of those users has a world-wide unique ID number which is the international mobile subscriber identity IMSI.” (Specification, Pages 4-5). Therefore, using the invention, “a user can be identified securely on (almost) any place of the world. Further the invention uses the very sophisticated billing system established by the telecommunication providers...” (Specification, Page 4). Herlin and Morrill do not teach or suggest that “the telecommunication provider authenticates that the customer is authorized to give a money transfer order using the subscriber identification module (SIM).” Claim 1. Therefore, Applicants respectfully submit that neither Herlin nor Morrill, nor any other art of record, either alone or in combination, teaches or suggests all the limitations of the instantly claimed invention as presently amended. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections under section 103.

Conclusion

In view of the foregoing, it is respectfully submitted that Claims 1, 3-6, 8, 10-14, 16, 20 and 23 fully distinguish over the applied art and are thus in condition for allowance. Notice to that effect is hereby earnestly solicited. If there are any further

issues in this application, the Examiner is requested to contact the undersigned at the telephone number listed below before issuance of a further office action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stanley D. Ference III", written over a horizontal line.

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